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In re Application of
GREDLEY, Sarah
Application No.: 10/521,139
Filing Date: 12 January 2005
Attorney Docket No.: 006329.00005
For: PICTURE FRAME

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on applicant's "Renewed Petition under 37 CFR 1.137(b)" filed 06 March 2006 in the above-captioned application.

BACKGROUND

On 23 May 2003, applicant filed international application PCT/GB03/02228 which claimed a priority date of 23 May 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 23 November 2004.

On 12 January 2005, applicant filed, *inter alia*: a transmittal letter to the US Designated/Elected Office Concerning a Filing under 35 U.S.C. 371; an application containing a specification, including claims and drawings; a Fee transmittal for FY 2005; copy of the international application; a preliminary amendment for continuation of PCT/GB03/02228; an application data sheet; and the instant petition and fee to revive the international application as to the United States under 37 CFR 1.137(b). In a decision dated 04 January 2006, applicant petition under 37 CFR 1.137(b) was dismissed without prejudice. Further, applicant was notified that the submission would be treated under 35 U.S.C. 111, not 35 U.S.C. 371.

On 06 March 2006, applicant filed the present "Renewed Petition under 37 CFR 1.137(b)."

DISCUSSION

International application PCT/GB03/02228 became abandoned as to the United States of America at midnight on 23 November 2004 for failure to pay the basic national fee.

A petition under 37 CFR 1.137(b) requesting that PCT/GB03/02228 be revived as to the United States on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Items (2) and (4) have been previously satisfied.

Item (1) has not been met. The filing of a continuation application under 35 U.S.C. 111(a) is acceptable as the required reply under 37 CFR 1.137(b). See MPEP § 711.03(c)(II)(A). However, the instant application has not properly claimed benefit under 35 U.S.C. 120 and 365(c) to PCT/GB03/02228 within the time period set forth in 37 CFR 1.78(a)(2). In order to claim benefit under 35 U.S.C. 120 and 365(c) to the international application, applicant may wish to consider filing a Petition for the Acceptance of Unintentionally Delayed Claim for Priority under 37 CFR 1.78(a)(3). It is also noted the reference in the first sentence of the substitute specification to 35 U.S.C. 371 is improper as the present application was filed under 35 U.S.C. 111(a), not 35 U.S.C. 371. Until continuity is properly claimed under 37 CFR 1.78, applicant has not filed the "required reply" necessary to satisfy item (1) of a grantable petition to revive the international application.

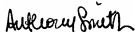
Item (3) has not been met. A review of the petition reveals that there is a question as to whether the delay was unintentional. The Manual of Patent Examining Procedure, Section 711.03(c), states that "a delay resulting from a deliberately chosen course of action of the part of the applicant does not become an 'unintentional' delay within the meaning of 37 CFR 1.137(b) because the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses." The declaration of Sarah Gredley states that she instructed the firm of Barter Brettell of her intentions to file a National Stage application in a telephone conversation on 30 September 2004, but due to stress; inexperience with the patent process; and temporary lack of finance, she failed to confirm her intention with Barter Brettell by the 23 November 2004 deadline. Further, Sarah Gredley admits that the delay was "due to mistaken belief that the U.S. National phase application could be filed later." As stated in the previous decision, the statements suggest that Sarah Gredley intentionally delayed submitting the basic national fee in order to defer patent fees and prosecution expenses. It is also noted that petitioner has not produced a copy of the instructions provided to her by Barker Brettell regarding the U.S. national phase deadline. The failure to produce such evidence raise the inference that the instructions were clearer. Therefore, in view of the deliberately chosen course of action, the delay cannot be considered to be unintentional and the petition may not be properly granted.

CONCLUSION

The renewed petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and international application no. PCT/GB03/02228 remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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